

REMARKS

A second non-final Office Action mailed April 13, 2004 has been received and carefully reviewed. Claims 1-15 and 24-31 are pending and currently rejected in the instant application. Claims 16-23 were withdrawn from further prosecution as being directed to a non-elected invention. New claims 32-40 have been added. Reconsideration of the application as amended is respectfully requested in view of the following remarks.

Though not specifically re-addressed in the Office Action Summary, Applicant infers that the prior objection to Figure 5 is now overcome by the Response and Amendment dated 1-20-2004.

The rejections are summarized as follows: Claims 1-2, 8, 15 and 24-31 stand rejected under §102(e) over *Niazi* (U.S. Patent No. 6,638,268); claims 3-4 stand rejected under §103(a) over *Niazi*, as applied to claim 1 and in further view of *Schaerf* (U.S. Patent No. 5,409,469); claims 5-6 stand rejected under §103(a) over *Niazi* as applied to claim 1 and in further view of *Bowe* (U.S. Patent Publication 2001/0039413); claims 7, and 9-10 stand rejected under §103(a) over *Niazi* as applied to claim 1 and in further view of *Lepulu et al.* (U.S. Patent No. 6,533,770); and claims 11-14 stand rejected under §103(a) over *Niazi* as applied to claim 1.

Niazi discloses a catheter for cannulating the coronary sinus. The catheter taught in *Niazi* includes an outer catheter 11 and an inner catheter 12. The inner catheter 12 "is constructed of a more liable, soft material such as silicone", relative to the outer catheter 11. Column 3, lines 13-15.

To anticipate a claim, the asserted reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. All claim elements and their limitations must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

Niazi fails to teach a guide catheter of the type contemplated in Applicant's claims which includes an inner sheath that has a distal end with a pre-formed shape, such that the inner sheath conforms to a shape of the outer sheath when retracted, but assumes the pre-formed shape when the distal end of the inner sheath is extended beyond the distal end of the outer sheath.

Although *Niazi* describes in some detail that the outer catheter 11 has a hook shape and has sufficient shape memory to return to its original shape when undistorted (see, e.g., Column 4, lines 21-26), *Niazi* is wholly silent on a pre-formed shape of its inner catheter 12.

Niazi does teach that a distal end 16 of the inner catheter 12 has a tip 17 made of material softer than the remainder of the inner catheter 12." Column 3, lines 31-33. This teaching, however, neither expressly nor implicitly suggests that the tip 17 has a pre-formed shape. Although the embodiment of Figure 6 is described as being reinforced with a helical wire coil 55, this reinforcement "does not prevent inner guide 52 from bending in a flexible manner" (*i.e.*, does not impart a pre-formed shape on the inner guide 52). Column 6, lines 46-54.

To sustain an anticipation rejection, the identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed Cir. 1989). Moreover, the elements must be arranged as required by the claim, although identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

Because *Niazi* fails to teach each an every element and element limitation recited in independent claims 1 and 24, such as the pre-formed shape of the inner sheath's distal end and structural behavior when retracted and extended relative to the outer sheath's distal end, these claims are not anticipated by *Niazi*. Dependent claims 2, 8, 15, and 25-31 are also not anticipated by *Niazi*, as these claims recite features in addition to those recited in the claim from which they depend.

Concerning the rejection of claims 3 and 4, the disclosure of *Schaerf* in combination with that of *Niazi* fails to render the subject matter of claims 3 and 4

unpatentable. Initially, *Schaerf* does not supply the elements and element limitations missing from *Niazi* with regard to Applicant's base claim 1. The combination of *Schaerf* and *Niazi* neither teaches nor suggests all of the Applicant's features recited in claims 1, 3, and 4, as is required to sustain a finding of *prima facie* obviousness. Accordingly, claims 3 and 4 are patentable over the asserted combination of *Niazi* and *Schaerf*.

With regard to the rejection of claims 5 and 6, the Examiner combines the teachings of *Niazi* and *Bowe* (US Patent Application Publication No. 2001/0039413) to support a finding of obviousness of these claims. Applicant respectfully brings to the Examiner's attention that the instant application and *Bowe* are assigned to common assignee, Cardiac Pacemakers, Inc. Applicant makes reference to the assignee information provided on the first page of the issued US Patent equivalent to *Bowe* (US Patent No. 6,592,581 previously removed as available prior art in addressing obviousness rejections in the prior office action response) and the Assignee of record information for the instant application recorded at reel 012817, frame 0088 to evidence such common ownership.

The instant application and *Bowe* were, at the time the invention of *Bowe* was made, owned by common assignee Cardiac Pacemakers, Inc. Accordingly, *Bowe* is not a qualified reference under 35 U.S.C. § 102(e) for purposes of evaluating obviousness, and, therefore, is not available under 35 U.S.C. § 103. As such, *Bowe* cannot properly be used as a reference to support the Examiner's instant rejection of claims 5 and 6 under 35 U.S.C. § 103.

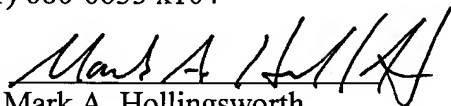
Concerning the obviousness rejections of claims 7, 9, 10 and 11-14, and without acquiescing to the Examiner's characterization of the relied-on references as they have been applied to Applicant's claims, Applicant believes it unnecessary to address all grounds for rejection of every dependent claim in view of the clear grounds for patentability of claim 1. These dependent claims include all of the limitations of claim 1 and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending there from is nonobvious." M.P.E.P. §2143.03;

citing *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicant, however, reserves the right to address these rejections should the Examiner maintain the rejection of the claim 1, notwithstanding Applicant's remarks presented hereinabove.

It is believed that pending claims 1-15 and 24-31, and newly added claims 32-40, are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if there are any questions regarding the above new claims or if prosecution of this application may be assisted thereby.

Respectfully submitted,
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